

REMARKS

The Office Action dated June 27, 2005, has been received and carefully considered. In this response, claims 14-16 have been added and claims 1, 3 and 7 have been amended. Entry of added claims 14-16, and the amendments to the claims 1, 3, 6 and 7, is respectfully requested. Reconsideration of the outstanding objections/rejections in the present application is also respectfully requested based on the following remarks.

I. **THE OBJECTION TO CLAIMS 1 AND 3**

On page 2 of the Office Action, claims 1 and 3 were objected to for various informalities. Claim 1 is missing a period at the end of the claim, and claim 3 has two periods at the end of the claim. Applicant has corrected each of these informalities.

In view of the foregoing, it is respectfully requested that the aforementioned objection to claims 1 and 3 be withdrawn.

II. **THE INDEFINITENESS REJECTION OF CLAIM 7**

On page 2 of the Office Action, claim 7 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. This rejection is hereby respectfully traversed.

Applicant has amended claim 7 to provide proper antecedent basis for "the cashing."

In view of the foregoing, it is respectfully requested that the aforementioned indefiniteness rejection of claim 7 be withdrawn.

III. THE ANTICIPATION REJECTION OF CLAIMS 1-3 AND 6

On page 2 of the Office Action, claims 1-3 and 6 were rejected under 35 U.S.C. § 102(e) as being anticipated by Tengel (U.S. Patent No. 5,940,812)¹. This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re Sun, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Id. “In addition, the prior art reference must be enabling.” Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention.” Id.

Regarding claims 1-3 and 6, the Examiner asserts that Tengel teaches a system and method that includes, among other things, “a document server coupled to [a] loan processor, the document server generates and sends [a] *loan document* to the customer, *based on the loan application*, when the loan processor determines that the customer should receive the loan, the loan processor sends the loan document to the customer through one of e-mail, facsimile, the network, a first printer coupled to the network, and a second printer coupled to another network

¹ Applicant respectfully submits that the Office Action mistakenly identified the Tengel reference as U.S. Patent No. 5,594,226.

(abstract, figs. 1, 2A, 2B, 5, and 9; column 4, line 53 - column 5, line 19 and column 8, line 37 - column 10, line 56.)

Applicant respectfully submits, however, that Tengel does not teach or suggest any feature or functionality that comprises “a document server coupled to the loan processor. . . [that] generates and sends the *loan document* to the customer, *based on the loan application*, when the loan processor determines that the customer should receive the loan, the loan processor sends the loan document to the customer through one of e-mail, facsimile, the network, a first printer coupled to the network, and a second printer coupled to another network,” as set forth in independent claim 1 and in similar fashion in independent claims 6 and 7, as amended. In particular, Applicant respectfully submits that Tengel does not teach any feature or functionality that generates and sends a *loan document* to the customer where the loan document is *based on the loan application*.

Rather, as set forth in the Abstract, Applicant respectfully submits that Tengel merely teaches a system and method uses customer provided information to: (1) determine and rank available loans, and (2) generate a loan application that is transmitted to the lender for loan approval:

A loan origination system including an apparatus and method for automatically matching a best available loan to a potential borrower, via a global telecommunications network. The loan origination system of the present invention brings together via the global telecommunications network potential borrowers and lenders. The loan origination system accepts and stores into a database borrower attributes entered by a potential borrower requesting a loan, via the global telecommunications network. The loan origination system also accepts and stores into the database credit related information regarding the potential borrower sent from at least one credit bureau. The loan origination system stores into the database respective loan acceptance criteria and respective loan attributes for an offered loan. The loan origination system compares the borrower attributes of the potential borrower with all of the loan acceptance criteria stored in the database to determine any available loans for the potential borrower. The loan attributes of the available loans are analyzed to determine rankings of best loans. From the

rankings of best loans, the borrower chooses a selected loan provided by a selected lender. *A loan application is automatically generated from the borrower attributes and is automatically sent to the selected lender for loan approval.* In addition, the loan origination system of the present invention provides to a lender information regarding borrowers and/or other competitive lenders in the loan market.

See, Tengal, Abstract (emphasis added).

Applicant respectfully submits, however, that -- as evidenced by the above excerpt -- Tengal does not teach or suggest any feature or functionality that generates and sends a *loan document* to the customer, where the loan document is *based on the loan application*. In fact, Applicant respectfully submits that beyond transmission of the loan application to a lender for processing, Tengal exclusively teaches features and functionality that occur before generation of a loan application.² In particular, there is no feature or functionality disclosed by Tengal that generates or sends document(s) that are *based on the loan application*. Accordingly, Applicant respectfully submits that Tengal does not teach or suggest any feature or functionality that generates and sends a loan document to a consumer, where the loan document is based on the loan application.

Claims 2-5 and 8-16 are dependent upon independent claim 1 or 7. Thus, since independent claim 1 and 7 should be allowable as discussed above, claims 2-5 and 8-16 should also be allowable at least by virtue of their dependency on independent claim 1 or 7. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, dependent claim 14 recites

² For example, the last steps disclosed by Tengal in the Abstract is the generation and transmission of the loan application to a lender for approval. Accordingly, Applicant respectfully submits that this is further evidence that Tengal does not teach or suggest generation and sending of loan documents *based on a loan application*, as expressly recited in each of the independent claims.

wherein the loan application is received by the loan processor before the loan document is generated. Applicant respectfully submits that Tengel does not teach or suggest the system of independent claim 1 wherein the loan application is received by the loan processor before the loan document is generated.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1-3 and 6 be withdrawn.

V. THE OBVIOUSNESS REJECTION OF CLAIMS 4, 5 AND 7-13

On page 4 of the Office Action, claims 4, 5 and 7-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tengel (U.S. Patent No.5,594,226) in view of Official Notice. This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner asserts that Tengel fails to teach that cashing a check indicates acceptance by the customer of the terms listed in the loan document, checking the validity of the check, and the loan document includes insurance information relating to the loan.

Applicants traverse this rejection because there is no support in the record for the conclusion that the identified features are “old and well known.” In accordance with MPEP § 2144.03, the Examiner must cite a reference in support of his position.

Further, Applicant respectfully submits that the pending obviousness rejections of claims 4, 5, 7 and 13 are overcome in light of the arguments and amendments set forth above in connection with the anticipation rejection of claims 1-3 and 6.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 4, 5, 7 and 13 be withdrawn.

V. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

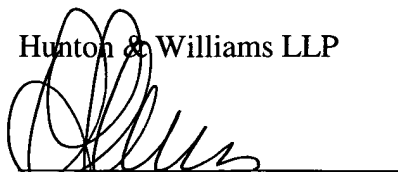
To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

By:

A handwritten signature in black ink, appearing to read 'Ozzie A. Farres', is written over a horizontal line.

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